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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,944	03/18/2004	Takashi Nagashima	119154	5166
25944	7590	05/12/2006	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			SAWHNEY, HARGOBIND S	
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			2875	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/802,944	Applicant(s) NAGASHIMA ET AL.	
	Examiner Hargobind S. Sawhney	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment filed on March 1, 2006 has been entered. Accordingly, claims 1 and 6 have been amended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu (US Patent No.: 6,238,119 B1)).

Regarding claims 1, 2 and 5, Liu ('119 B1) discloses a light pen 23 (Figure 3) comprising:

- a rod-like body portion 20 (Figure 3, column 2 , line 14); a leading end portion 21- combination of elements 21 and 22 (Figure 3) removably – threaded end connected to element 20 - mounted to the body portion 20 (Figure 3, column 2 , lines 14-16); a light emitter 32 (Figure 3, column 2 , line 26); an ON/OFF switch 310 (Figure 3, column 2 , line 24); the light emitter 32 and the switch 310 – actual switching elements - disposed in the leading end portion 21 (Figure 12); the light emitter portion 22 receiving a light emitter 32 (Figure 3,

column 2 , lines 21 and 22); the switch portion 21'- the cavity defined by the rod-like body portion 21 - receiving the switch 310 (Figure 3); and a power source 30 received in the body portion 20 (Figure 3, column 2, line 18).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US Patent No.: 6,238,119 B1) in view of Huang (US Patent No.: 5,343,376).

Liu ('119 B1) discloses a light pen 23 (Figure 3) comprising a light emitting portion receiving a light emitter element 32 operationally coupled to a circuit 31 and a switch 310. However, Lui ('119 B1) does not teach the light emitting portion including a current controlled element.

On the other hand, Huang ('376) discloses a light-emitting pointer (Figure 1) comprising a light emitter module 2 operationally connected to a circuit board 25, which includes current controlling element Q1 (Figures 1 and 5, column 1, lines 57-59; column 2, lines 10 and 63-65).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the light pen of Liu ('119 B1) by providing current controlling element

operationally coupled to the circuit board for the benefits of stabilizing current supplied to light emitting diodes for their predetermined performance.

6. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inuiya (US Patent No.: 3,885,096).

Inuiya ('096) discloses a light pen (Figure 3) comprising:

- a rod-like body portion 44 (Figure 3, column 2 , line 28); a leading end portion 45 (Figure 3, column 2 , lines 31-33) moveably mounted to the body portion 44 (Figure 3, column 2 , lines 31-33); a light emitter 42 (Figure 3, column 2 , line 31); an ON/OFF switch 48a,48b; the light emitter 32 and the switch 48a,48b disposed in the leading end portion 45 (Figure 3).

However, Inuiya ('096) does not specifically teach a light pen comprising a removable leading end portion.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to make the leading end of the light pen of Inuiya ('096) removable for replacement or repair of internals including a light emitter and a switch, since it has been held that making a component removable is a merely a matter obvious engineering choice, and involves only routine skill in the art. USPQ 348, 349 (CCPA 1961)

7. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher (US Patent No.: 4,315,282) in view of Inuiya (US Patent No.: 3,885,096).

Regarding Claim 6, Schumacher ('282) discloses a presentation system (Figure 1) comprising a light pen 18:

- a material presentation apparatus (Figure 1, column 5, line 2) comprising: a material mounting pedestal 20 (Figure 1, column 5, line 18); the material mounted on the mounting pedestal 20 from which a virtual screen is generated (Figure 1, column 5, lines 17-20); a photographic section 24 supported on the material mounting pedestal 20 photographing the material (Figure 1, column 5, lines 17-20) on a display device 12 (Figure 1, column 5, lines 2 and 3); an image output section 31 (Figure 1, column 5, lines 41-45); a controller section 55 executing image processing (Figure 1, column 5, lines 4-9 and 63-68); the controller section calculating coordinates of the light emitter, and performing a predetermined pointing function at the coordinates of the display device 12 corresponding to the calculated coordinates of the emitter on the virtual screen upper surface of the material mounting pedestal 20; and
- a light pen 18 (Figure 1, column 5, line 12) emitting light on the virtual screen - upper surface of the material-mounting pedestal 20.

However, Schumacher ('282) does not specifically teach a light pen including a removable leading portion receiving a light emitter and a switch within itself.

On the other hand, Inuiya ('096) discloses a light pen (Figure 3) comprising:

- a rod-like body portion 44 (Figure 3, column 2, line 28); a leading end portion 45 (Figure 3, column 2, lines 31-33) moveably mounted to the body

portion 44 (Figure 3, column 2 , lines 31-33); a light emitter 42 (Figure 3, column 2 , line 31); an ON/OFF switch 48a,48b; the light emitter 32 and the switch 48a,48b disposed in the leading end portion 45 (Figure 3).

However, neither combined nor individual teaching of Schumacher ('282) and Inuiya ('096) specifically teaches a removable light pen comprising a leading end.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to make the leading end of the light pen of Schumacher ('282) in view of Inuiya ('096) removable for replacement or repair of internals including light emitter and switch, since it has been held that making a component removable is a merely a matter obvious engineering choice, and involves only routine skill in the art. USPQ 348, 349 (CCPA 1961)

Regarding Claim 8, Schumacher ('282) in view of Inuiya ('096) discloses the presentation system further including:

- a monitor 19 – combination of elements 12 and 19 (Figure 1) – displaying an image photographed by the photographing section 24 (Schumacher, Figure 1, column 5, lines 17-20); and
- the virtual screen – the portion bearing the presentation material on the material mounting pedestal 20 – being set on the monitor 19 (Schumacher, Figure 1); and the photographic section 24 photographing the monitor 19 (Schumacher, Figure 1).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher (US Patent No.: 4,315,282) in view of Inuiya (US Patent No.: 3,885,096)

as applied to claim 6 above, and further in view of Tang et al. (US Patent No.; 5,239,373).

Schumacher ('282) in view of Inuiya ('096) discloses the presentation system further including a photographic section and a presentation material-mounting table. However, neither combined nor individual teaching of Schumacher ('282) and Inuiya ('096) discloses an optical filter disposed in the optical path of the photographing section.

On the other hand, Tang et al. ('373) discloses a presentation system (Figures 3 and 7 and 4) comprising an optical filter 42 disposed in the optical path of the photographic section 12 allowing photographing only the light of a specific wavelength (Figure 7, column 7, lines 7-11).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the presentation system of Schumacher ('282) in view of Inuiya ('096) by providing and positioning the optical filter as taught by Tang et al. ('373) for benefit and advantages of blocking the images, not desired, from being detected by the camera.

Response to Amendment

9. Applicant's arguments filed on March 1, 2006 with respect to the 35 U.S.C. 102(b) rejections of claims 1-5; and 35 U.S.C. 103(a) rejections of claims 6-8 have been fully considered but are moot in view of the new ground(s) of rejections necessitated by the amendment.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kanzaki et al. (U.S. Patent No. 6,882,119 B1), Badyal et al. (U.S. Patent No. 6,151,015), Seebach (U.S. Patent No. 5,453,759), Baldwin (U.S. Patent No. 4,883,926) and Bartlett (U.S. Patent No. 2,811,632)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S. Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 8:00 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571 272 2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HSS
5/10/2006


ALI ALAVI
PRIMARY EXAMINER